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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/882,416	06/15/2001	Petrus Van Beek	KLR 7146.100	8410
<div>7590 02/07/2007 Timothy A. Long Chernoff, Vilhauer, McClung and Stenzel, L.L.P. 1600 ODS Tower 601 SW Second Ave. Portland, OR 97204</div>			<div>EXAMINER PHAM, KHANH B</div> <div>ART UNIT 2166 PAPER NUMBER</div>	
SHORTENED STATUTORY PERIOD OF RESPONSE		MAIL DATE	DELIVERY MODE	
3 MONTHS		02/07/2007	PAPER	

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary	Application No.	Applicant(s)	
	09/882,416	BEEK ET AL.	
	Examiner	Art Unit	
	Khanh B. Pham	2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 November 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-51 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-51 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date <u>8/22/06</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-59 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claims 1-59 direct to “a digital file stored on a computer readable medium”; however, the claimed “digital file” contains only non-functional descriptive material.

Descriptive material can be characterized as either “functional descriptive material” or “nonfunctional descriptive material”. In this context, “functional descriptive material” consists of data structures and computer programs which impart functionality when employed as a computer component. (The definition of “data structure” is “a physical or logical relationship among data elements, designed to support specific data manipulation functions.” The New IEEE Standard Dictionary of Electrical and Electronic Terms 308 (5th ed. 1993).).

“Nonfunctional descriptive material” includes, but is not limited to music, literary works, **photographs** and compilation or **mere arrangement of data**. Both type of “descriptive material” are nonstatutory when claimed as descriptive material per se. Warmerdam, 33 F. 3d at 1360, 31 USPQ2d at 1759. When functional descriptive material is recorded on some computer-readable medium it becomes structurally and functionally interrelated to the medium and will be statutory in most cases since use of

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technology permits the function of the descriptive material to be realized. Claims 1-59 are directed to nonfunctional descriptive material per se and therefore nonstatutory.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

3. **Claims 47-49 and 54 are rejected under 35 U.S.C. 102(a)** as being anticipated by “JPEG 2000 Image Coding System” Final Committee Draft Version 1.0, March 16, 2000, (supplied by Applicant in IDS, paper No. 6), hereinafter “IT-JPEG2000”.

As per claim 47, IP-JPEG2000 teaches a digital file stored on a computer readable medium (see page 139, Fig. I-1), said digital file comprising:

- “a plurality of boxes containing data arranged in a manner consistent with the JPEG2000 specification and suitable to render an image” at page 139, Fig. I-1;
- “at least one of said boxes being a UUID box” at page 139, Fig. I-1, page 140, section I.4.5 and page 158, section 1.9.2;
- “including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image” at page 158, sections I.9.2 and I.9.3.

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(IT-JPEG2000 teaches that UUID boxes can be used to store binary data, and UUID Info boxes, which act as index for the UUID's in the file, contains a list of UUID's and specifies links (i.e., "location") to more information. UUID boxes and UUID Info boxes are distinct but within the JPEG2000 file.)

As per claim 48, IP-JPEG2000 teaches the digital file of claim 47 wherein "said information is in XML format" at page 157, section I.9.1.

As per claim 49, IP-JPEG2000 teaches the digital file of claim 47 wherein "said digital file is compliant with the JPEG2000 standard" at page 140, section I.4.6.

As per claim 54, IT-JPEG2000 teaches the digital file of claim 47 wherein "said information includes links to information external to said digital file" at page 159, section I.9.3.2.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

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5. **Claims 41-42 and 44-46** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Pereira** ("MPEG-7: a Standard for Describing Audiovisual Information", 1999), hereinafter "**Pereira**", and in view of "MPEG-7 Multimedia Description Scheme, Description Definition language V 3.0, N3391", (supplied by Applicant in IDS, paper No. 6), hereinafter referred to as "**N3391**".

As per claim 41, Pereira teaches a digital file stored on a computer readable medium (page 6/4, 3rd paragraph), said digital file comprising:

- "a MPEG-7 description scheme that includes the identification of the format of at least one of audio and visual media" at page 6/1, last paragraph;
- "said description scheme including data for rendering said at least one of said audio and visual media" at page 6/2, 2nd paragraph (i.e., "reproduction data");
- "said at least one of said audio and visual media being contained within said description scheme" at page 6/2, 2nd paragraph. (Pereira teaches that "MPEG-7 descriptions may be physically co-located with the 'reproduction data', in the same data stream")

Pereira does not explicitly teach: "said description scheme includes a choice of two different encoding scheme for data, namely, base16 and base64" as claimed. However, N3391 describes a MPEG-7 description scheme, which includes "choice of two different encoding scheme for data, namely base16 and base64" at page 11,

section 6.2.4.7. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention was made to employ the encoding scheme as taught in N3391 into Pereira's description scheme because N3391 represents the International Standard for MPEG-7 description scheme. Using the encoding scheme as suggested by N3391 will ensure that the description scheme will be compliant with the standard, and therefore compatible with all applications implemented based on the standard.

As per claim 42, Pereira and N3391 teach the digital file of claim 41 discussed above. Pereira also teaches: "wherein said description scheme is InlineMedia".

(The examiner relies on Applicant's specification for the definition of "InlineMedia", "that permits the identification of the format of the media stream" and "enables the description of audio and/or visual data located within the description itself, without having to refer to a location external to the description" (page 7, last paragraph). As discussed in the rejection of claim 41 above, Pereira teaches a similar description scheme and therefore anticipated the claimed element.)

As per claim 44, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base16 is part of an element name MediaData16" at page 11, section 6.2.4.7.

As per claim 45, Pereira and N3391 teach the digital file of claim 43 as discussed above. N3391 also teaches: "said base64 is part of an element name MediaData64" at page 11, section 6.2.4.7.

As per claim 46, Pereira and N3391 teach the digital file of claim 41 discussed above. Pereira also teaches: "wherein said data is binary" at page 6/1, 2nd paragraph (i.e., "digital" format).

Response to Arguments

6. Applicant's arguments filed April 25, 2006 have been fully considered but they are not persuasive. The examiner respectfully traverses applicant's arguments.

In view of the declaration filed 4/25/2006 and applicant's statement claiming common assignee to the Qian reference, the 103(a) rejection to claims 1-40, 50-53 and 55-59 is hereby withdrawn.

Regarding the 35 U.S.C 101 rejection to claims 1-59, applicant argued that digital files stored on a computer readable medium are statutory subject matter based on an incorrect assumption that "a computer-readable medium storing literary work in a novel data format" are patentable (Applicant's remark, page 11). The examiner respectfully disagrees.

While applicant correctly states on page 10 of the remarks that "a computer disk containing Dostoyevsky's "Crime and Punishment" does not become patentable subject

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matter merely because the literary work is stored on a computer readable medium", it is unsupported how a computer-readable medium storing Dostoyevsky's "Crime and Punishment" in PDF or DOC format (or any novel data format) would become patentable ?

Applicant further argued that "independent claims 1 includes the limitations of "a plurality of boxes containing data... **suitable to render an image when read by a computer**" and "including information within said metadata box **describing the content of said image**", thereby describing the functional relationship between the metadata box and the "plurality of boxes... containing data suitable to render an image." The examiner respectfully submits that "**data suitable to render an image**" and information "**describing the content of said image**" are clearly **nonfunctional** descriptive material. The "data" and "information" themselves, even if stored on a computer readable medium, do not cause a computer to perform any function when inserted in to a computer, the data are only stored so as to be read or outputted by a computer without creating any functional interrelationship. MPEP chapter 2106, Patentable Subject Matter - Computer-Related Inventions provides:

Descriptive material that cannot exhibit any functional interrelationship with the way in which computing processes are performed does not constitute a statutory process, machine, manufacture or composition of matter and should be rejected under 35 U.S.C. 101. Thus, Office personnel should consider the claimed invention as a whole to determine whether the necessary functional interrelationship is provided.

Where certain types of descriptive material, such as music, literature, art, **photographs and mere arrangements or compilations of facts or data, are merely stored so as to be read or outputted by a computer without creating any functional interrelationship**, either as part of the stored data or as part of the computing processes performed by the computer, **then such descriptive material alone does not impart functionality either to the data as so structured, or to the computer**. Such "descriptive material" is not a process, machine, manufacture or composition of matter. (Data consists of facts, which become information when they are seen in context and convey meaning to people. Computers process data without any understanding of what that data represents. Computer Dictionary 210 (Microsoft Press, 2d ed. 1994).)

In conclusion, the claims are directed to a digital photograph file stored on a computer readable medium, which does not provide any functionality when inserted into a computer and requires a separate "suitable JPEG2000 viewer" (See specification page 5) to render the image and process the information in the file . Claims 1-59 are therefore non statutory and the 101 rejection is hereby maintained.

Regarding claims 41-42 and 46, applicant argued that these claims are allowable because they include limitation of claim 43. However, claim 43 was is previously rejected as unpatentable over Pereira in view of N3391. Claims 41-42 and 46 are therefore rejected based on the same ground.

Regarding claims 47-49 and 54, applicant argued that IT-JPEG 2000 does not teach “including information within said UUID box indicating the location of binary data, within said file and not within said UUID box, associated with said image”. On the contrary, IT-JPEG2000 teaches that UUID boxes can be used to store binary data, and UUID Info boxes, which act as index for the UUID's in the file, contains a list of UUID's and specifies links (i.e., “location”) to more information. UUID boxes and UUID Info boxes are distinct but within the JPEG2000 file. The examine therefore mapped IT-JPEG2000's UUID Info boxes to the claimed “UUID box”.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Khanh B. Pham whose telephone number is (571) 272-4116. The examiner can normally be reached on Monday through Friday 7:30am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on (571) 272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Khanh B. Pham
Primary Examiner
Art Unit 2166

January 31, 2007

